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PATENT
Attorney Docket No. 08011.3012

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:)
Adrian VELTHIUS et al.) Group Art Unit: 3622
Application No.: 09/989,448) Examiner: CARLSON, Jeffrey D.
Filed: November 21, 2001) Confirmation No. 1416
For: A SYSTEM AND METHOD FOR)
PROVIDING INCENTIVES TO)
CUSTOMERS OVER A COMPUTER)
NETWORK)

Attention: Mail Stop Appeal Brief - Patents

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

APPEAL BRIEF UNDER BOARD RULE § 41.37

In support of the Notice of Appeal filed May 11, 2007, the period for response to which extends through July 11, 2007, and further to Board Rule 41.37, Appellants present this brief and enclose herewith a check for the fee of \$500.00 required under 37 C.F.R. § 1.17(c).

This Appeal responds to the Final Office Action mailed January 16, 2007, which finally rejected claims 1-3 and 7-14.

If any additional fees are required or if the enclosed payment is insufficient, Appellants request that the required fees be charged to Deposit Account No. 06-0916.

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TABLE OF CONTENTS

I. Real Party in Interest	3
II. Related Appeals and Interferences.....	4
III. Status of Claims.....	5
IV. Status of Amendments	6
V. Summary of Claimed Subject Matter.....	7
VI. Grounds of Rejection.....	9
VII. Argument.....	10
VIII. Claims Appendix to Appeal Brief Under Rule 41.37(c)(1)(viii)	16
IX. Evidence Appendix to Appeal Brief Under Rule 41.37(c)(1)(ix)	19
X. Related Proceedings Appendix to Appeal Brief Under Rule 41.37(c)(1)(x)	20

I. Real Party in Interest

The real party in interest is Advertising.com, the assignee of record, which is a subsidiary of America Online, Inc., which is a subsidiary of Time Warner, Inc.

II. Related Appeals and Interferences

There are currently no other appeals or interferences, of which Appellants, Appellants' legal representative, or the assignee are aware, that will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

III. Status of Claims

In the Final Office Action mailed January 16, 2007, the Examiner rejected claims 12-14 under 35 U.S.C. § 112, second paragraph; rejected claims 1, 3, 7-9, and 11-14 under 35 U.S.C. § 103(a) as being unpatentable over Mankoff et al. (U.S. Patent No. 6,385,591) in view of Sim (KR2000030358A); and rejected claims 2 and 10 under 35 U.S.C. § 103(a) as being unpatentable over Mankoff in view of Sim and in further view of Golden et al. (U.S. Patent No. 5,781,648).

The final rejection of claims 1-3 and 7-14 is being appealed and a list of the claims on appeal is found in the attached Claims Appendix.

Furthermore, each claim of this patent application is separately patentable, and upon issuance of a patent will be entitled to a separate presumption of validity under 35 U.S.C. § 282.

IV. Status of Amendments

All claim amendments have been entered.

V. Summary of Claimed Subject Matter

The subject matter set forth in independent claim 1 relates to a method for providing redeemable purchasing incentives to customers. The method includes displaying to a user of a first user computer, a banner advertisement related to a purchasing incentive. See at least pages 9-10, paragraph [0029]. In response to and in association with the display of the banner advertisement, the method receives from the user through the first user computer an identifier associated with a second user computer. See at least pages 9-10, paragraph [0029]. In response to the receipt of the identifier, the method transmits a coupon to the second computer. See at least pages 10-11, paragraph [0031]. The method further displays the coupon on the second computer, whereby the coupon can be redeemed directly through its display on the second computer. See at least page 3, paragraph [0007] and pages 10-11, paragraph [0031].

The subject matter set forth in independent claim 9 relates to a computer-readable medium containing instructions for controlling a computer to perform a method for providing redeemable purchasing incentives to customers. The method includes displaying to a user of a first user computer, a banner advertisement related to a purchasing incentive. See at least pages 9-10, paragraph [0029]. In response to and in association with the display of the banner advertisement, the method receives from the user through the first user computer an identifier associated with a second user computer. See at least pages 9-10, paragraph [0029]. In response to the receipt of the identifier, transmitting a coupon to the second computer. See at least pages 10-11,

paragraph [0031]. Displaying the coupon on the second computer, whereby the coupon can be redeemed directly through its display on the second computer. See at least page 3, paragraph [0007] and pages 10-11, paragraph [0031].

The subject matter set forth in independent claim 12 relates to a system for providing redeemable purchasing incentives to customers. The system comprises a web server programmed to transmit a banner advertisement related to a purchasing incentive to a first user computer over a network and programmed to receive an identifier that is associated with a second user computer from a user of the first user computer. See at least pages 9-11, paragraphs [0029] and [0031]; see also FIG. 3. The system further comprises an ad server programmed to receive the identifier from the web server and programmed to transmit a coupon to the second computer. See at least page 3, paragraph [0007] and pages 10-11, paragraph [0031]; see also FIG. 2.

VI. Grounds of Rejection

- A. Claims 12-14 stand rejected under 35 U.S.C. § 112, second paragraph.
- B. Claims 1, 3, 7-9, and 11-14 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Mankoff et al. (U.S. Patent No. 6,385,591) in view of a Korean patent document to Sim (KR2000030358A).
- C. Claims 2 and 10 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Mankoff in view of Sim and in further view of Golden et al. (U.S. Patent No. 5,781,648).

VII. Argument

A. The Board Should Reverse the Rejection of Claims 12-14 Under § 112 Because the Claims are Definite

Appellants respectfully traverse the rejection of claims 12-14 under 35 U.S.C. § 112, second paragraph, as being indefinite. With regard to claim 14, the Examiner contends “[i]t is unclear what structure (programmed capability) is provided that enables the suggested redemption abilities.” See Final Office Action at page 2. Appellants respectfully submit that the claim is not indefinite because the fact that the coupon is redeemable by its display does not require a recitation of any structure that is used to redeem it. For example, Appellants’ specification discloses that, in one embodiment, “[t]he consumer can then visit the retail location and show the retailer the promotional information (coupon) displayed on the wireless device in order to redeem the coupon.” See page 3, paragraph [007]. Accordingly, the preceding is one way that a coupon may be redeemed.

The Examiner contends in the Advisory Action mailed April 27, 2007, that claim 14 “should be further defining an element of the system of claim 12 (i.e. a server), rather than describing device display capabilities or redemption capabilities.” Appellant respectfully submits that 35 U.S.C. § 112 does not impose any such requirement. Accordingly, claim 12 recites, in part, “an ad server programmed to receive the identifier from the web server and programmed to transmit a coupon to the second computer.” Furthermore, dependent claim 14 further clarifies features of the “coupon” that was transmitted to the “second command. Thus, claim 14 clearly recites additional features that define subject matter recited in its independent claim.

Appellants note that the MPEP explains that the test for indefiniteness is whether “the claims set out and circumscribe a particular subject matter with a reasonable degree of clarity and particularity.” See MPEP §2173 at § 2173.02 (“Clarity and Precision”). “If the claims when read in light of the specification reasonably apprise those skilled in the art of the scope of the invention, § 112 demands no more.” *S3, Inc. v. Nvida Corp.*, 259 F.3d 1364, 1367, 59 USPQ2d 1745, 1747 (Fed. Cir. 2001), quoting *Miles Laboratories, Inc. v. Shandon*, 997 F.2d 870, 875, 27 USPQ2d 1123, 1126 (Fed. Cir. 1993). Since the claims meet the requirements of 35 U.S.C. § 112, second paragraph, Appellants request that the Board reverse the rejection.

B. The Board Should Reverse the Rejection of Claims 1, 3, 7-9, and 11-14 Under § 103(a) Because A Prima Facie Case of Obviousness Has Not Been Established

Appellants respectfully traverse the rejection of claims 1, 3, 7-9, and 11-14 under 35 U.S.C. § 103(a) as being unpatentable over Mankoff in view of Sim because a *prima facie* case of obviousness has not been established. With regard to Sim, Appellants note that Sim is a Korean patent document. However, both the Examiner’s citations in the Office Action and Appellants’ citations in this paper are with respect to WO 01/63507 A1, an English language version of Sim.

To establish a *prima facie* case of obviousness, the prior art must teach or suggest all of the claim elements. See MPEP § 2142, 8th Ed., Rev. 5 (August 2006). Moreover, “in formulating a rejection under 35 U.S.C. § 103(a) based upon a combination of prior art elements, it remains necessary to identify the reason why a person of ordinary skill in the art would have combined the prior art elements in the

manner claimed." USPTO Memorandum from Margaret A. Focarino, Deputy Commissioner for Patent Operations, May 3, 2007, page 2. In this application, a *prima facie* case of obviousness has not been established for at least the reason that the applied prior art fails to teach or suggest each and every element of the claims.

Independent claim 1 recites a method including, among other steps, "in response to and in association with the display of the banner advertisement, receiving from the user through the first user computer an identifier associated with a second user computer" and "in response to the receipt of the identifier, transmitting a coupon to the second computer." The prior art, whether taken individually or in combination, does not teach at least these elements of independent claim 1.

In the Mankoff system, a coupon is transmitted from a server directly to either a personal computer or a PDA (Fig. 1), a PDA is synchronized with a personal computer to download coupon offers to the PDA (Fig. 2), or a coupon is directly downloaded to a PDA from a retail site web server (Fig. 3). Thus, Mankoff discloses direct transmission of a coupon to a device. However, Mankoff fails to disclose or suggest that "in response to and in association with the display of the banner advertisement, receiving from the user through the first user computer an identifier associated with a second user computer" and "in response to the receipt of the identifier, transmitting a coupon to the second computer," as recited in independent claim 1 (emphasis added). That is, Mankoff does not teach or suggest Appellants' claimed method in which the claimed "first computer" and "second computer" operate as claimed. Furthermore, the Examiner has not offered any evidence demonstrating that the prior art teaches that an "identifier"

is received from a user and, "in response ..., transmitting a coupon to a second computer," as required by claim 1.

Moreover, Sim does not compensate for the deficiencies of Mankoff. Instead, Sim discloses "a coupon serving system [which] allows a customer to buy commodities or use services through the use of coupons received in his or her wireless communication terminal equipment." See page 3. In the Sim system, data transmitting server 7 includes a coupon data transmission program that transmits coupon data to wireless communication terminal equipments 2. See page 4. Thus, Sim discloses direct transmission of a coupon from a server to a wireless device. However, Sim does not teach or suggest "receiving from the user through the first user computer an identifier associated with a second user computer" and "in response to the receipt of the identifier, transmitting a coupon to the second computer," as recited in independent claim 1 (emphasis added).

For at least the above reasons, the prior art, taken individually or in combination, do not teach or suggest each and every element of independent claim 1. Furthermore, independent claims 9 and 12, while of a different scope from claim 1 and each other, include recitations of a similar scope as claim 1. Accordingly, a *prima facie* case of obviousness has not been established with respect to independent claims 1, 9, and 12. Furthermore, claims 3, 7, 8, 11, 13, and 14 are allowable at least due to their dependence from allowable independent claims 1, 9, and 12. Therefore, the Board should reverse the rejection of claims 1, 3, 7-9, and 11-14 under 35 U.S.C. § 103(a).

C. The Board Should Reverse the Rejection of Claims 2 and 10 Under § 103(a) Because A Prima Facie Case of Obviousness Has Not Been Established

Appellants respectfully traverse the rejection of claims 2 and 10 under 35 U.S.C. § 103(a) as being unpatentable over Mankoff in view of Sim and in further view of Golden. As discussed above, Mankoff and Sim, individually or in combination, do not teach or suggest at least “in response to and in association with the display of the banner advertisement, receiving from the user through the first user computer an identifier associated with a second user computer” and “in response to the receipt of the identifier, transmitting a coupon to the second computer,” as required by independent claims 1 and 9, from which claims 2 and 10 respectively depend. In the Final Office Action, the Examiner contends Golden teaches “a feature whereby the user may download only a certain number of coupons.” See Final Office Action at page 5. Even if the Examiner’s characterization of Golden is correct, which Appellants do not concede, Golden does not compensate for the deficiencies of Mankoff and Sim already discussed. That is, Golden also does not teach or suggest that “in response to and in association with the display of the banner advertisement, receiving from the user through the first user computer an identifier associated with a second user computer” and “in response to the receipt of the identifier, transmitting a coupon to the second computer,” as required by independent claims 1 and 9.

Claims 2 and 10 depend from independent claims 1 and 9, respectively, and thus include all elements of their respective base claims. Accordingly, even if Golden were combined with Mankoff and Sim as the Examiner proposed, the combination still does not teach or suggest all elements recited in independent claims 1 and 9, and required

by dependent claims 2 and 10. Accordingly, Mankoff, Sim, and Golden, taken individually or in combination, do not teach or suggest all of the elements required by dependent claims 2 and 10. Therefore, the Board should also reverse the rejection of claims 2 and 10 under 35 U.S.C. § 103(a).

Conclusion

For at least the reasons given above, pending claims 1-3 and 7-14 are allowable over the prior art. Therefore, Appellants respectfully request the Board to reverse the Examiner's rejection of claims 1-4 and 7-14.

To the extent any extension of time under 37 C.F.R. § 1.136 is required to obtain entry of this Appeal Brief, such extension is hereby respectfully requested. If there are any fees due under 37 C.F.R. §§ 1.16 or 1.17 which are not enclosed herewith, including any fees required for an extension of time under 37 C.F.R. § 1.136, please charge such fees to our Deposit Account No. 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: July 6, 2007

By: 
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VIII. Claims Appendix to Appeal Brief Under Rule 41.37(c)(1)(viii)

1. A method for providing redeemable purchasing incentives to customers, comprising:

displaying to a user of a first user computer, a banner advertisement related to a purchasing incentive;

in response to and in association with the display of the banner advertisement, receiving from the user through the first user computer an identifier associated with a second user computer;

in response to the receipt of the identifier, transmitting a coupon to the second computer; and

displaying the coupon on the second computer, whereby the coupon can be redeemed directly through its display on the second computer.

2. The method of claim 1, wherein the transmitting further includes transmitting the coupon to the second computer, provided the second computer has received less than a predetermined number of coupons.

3. The method of claim 1, where the displaying further comprises displaying a subset of information associated with the coupon to accommodate display characteristics of the second computer.

4 - 6. (Canceled)

7. The method of claim 1, wherein the transmitting of the coupon to the second computer further comprises transmitting the coupon to a display.
8. The method of claim 7, wherein the display is associated with a wireless telephone.
9. A computer-readable medium containing instructions for controlling a computer to perform a method for providing redeemable purchasing incentives to customers, comprising:
 - displaying to a user of a first user computer, a banner advertisement related to a purchasing incentive;
 - in response to and in association with the display of the banner advertisement, receiving from the user through the first user computer an identifier associated with a second user computer;
 - in response to the receipt of the identifier, transmitting a coupon to the second computer; and
 - displaying the coupon on the second computer, whereby the coupon can be redeemed directly through its display on the second computer.

10. The computer-readable medium of claim 9, wherein the transmitting further includes transmitting the coupon to the second computer, provided the second computer has received less than a predetermined number of coupons.

The computer-readable medium of claim 9, where the displaying further displaying a subset of information associated with the coupon to ate display characteristics of the second computer.

A system for providing redeemable purchasing incentives to customers,

:b server programmed to transmit a banner advertisement related to a incentive to a first user computer over a network and programmed to receive r that is associated with a second user computer from a user of the first user and

:d server programmed to receive the identifier from the web server and :d to transmit a coupon to the second computer.

The system of claim 12, wherein the web server is further programmed to banner advertisement from the ad server and subsequently transmit the ertisement.

The system of claim 12, wherein the coupon transmitted to the second omprises a coupon that can be redeemed directly through its display on the nputer.

IX. Evidence Appendix to Appeal Brief Under Rule 41.37(c)(1)(ix)

None.

X. Related Proceedings Appendix to Appeal Brief Under Rule 41.37(c)(1)(x)

None.